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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/801,177

03/15/2004

Richard S. Belliveau

1469

27550

7590

03/08/2005

WALTER J, TENCZA JR.
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EXAMINER

LEE, Y MY QUACH

ART UNIT

PAPER NUMBER

2875

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H.A

Office Action Summary

Application No.

10/801,177

Applicant(s)

BELLIVEAU, RICHARD S.

Examiner

Y Quach Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-78 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION***Reissue Applications******Prosecution History***

1. An election of species requirement was made in the original prosecution of the patent under reissue. The requirement mailed 5/23/01 required election of species between different groups and subspecies. The first group is directed to drawing figures 2A, 2B, 3A to 3C and 3F, the second group is directed to drawing figure 3D, the third group is directed to drawing figure 3E, the fourth group is directed to drawing figure 9A and 9B, and different subspecies are directed to 4(A-C), 5(A-C), 6(A-C), 7(A-C), 8(A-C) and 12(A-C). Group 1, claims 1 to 9, 25, 26 and 50 directed to a plurality of light sources mounted on a flexible substrate with a flexible device for flexing the flexible substrate by applying pressure to the substrate to cause the substrate to deform in a first state and to not deform in a second state to cause the light emitted from the light sources concentrated in different directions, was elected without traverse on 5/23/01. Prosecution was conclude with claims 1 to 9, 25, 26 and 50 being allowed on November 28, 2001 subsequent to a rejection and the non elected claims 10 to 24 and 27 to 49 being canceled. U.S. patent 6,357,893 was issued on March 19, 2002. No continuation or divisional application was filed.

2. This application is a reissue of the patent 6,357,893. The original allowed claims 1-9, 25, 26 and 50 which are also patent claims 1 to 12 remain and claims 13 to 78 are newly added. The added claims are directed to a plurality of different wavelength light emitting diodes mounted on a substrate located in a first housing and having ventilation holes with a fan forcing air through the holes, the light emitting diodes connecting to different circuits on the substrate so that different intensity of the light and different color temperature of the light projected on a surface can be varied independently and controlled, a liquid crystal emulsion filter, a remote control for controlling the rotation of the first housing relative to a second housing having a communications line, the filter being varied by communications received over the communications line, and a yoke rotated with respect to the first and second housing.

Discussion regarding errors correctable by reissue

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3. 35 U.S.C. § 251 particularly limits, through the “error” requirement, which types of errors are correctable by reissue. Defects in the specification, drawings or claims which render the patent wholly or partly in operative or invalid may be corrected. However, with respect to the correction of defects in claims, the patent must be “deemed wholly or partly inoperative or invalid ... by reason of the patentee claiming more or less than he had a right to claim in the patent”. In other words, limitations can be added or removed from a claim to expand or contract its subject matter so it matches what patentee had a right to claim in the original patent. No reissued claim can be obtained on subject matter which the patentee could not have secured in the original patent.

4. In the present case, Applicant states that the defector or “error” is one of claiming less than he had a right claim (Reissue Declaration). The issue is whether Applicant had a right to claim in the original patent what is now claimed in the reissue application. The Federal Circuit has adopted the previously established principle that applicants are “estopped from obtaining by reissue claims which, because of a requirement for restriction in which they had acquiesced, they could not claim in their patent”. In re Orita, 550 F.2d 1277, 2380, 193 USPQ 145, 148 (CCPA 1977).

5. Applicant acquiesced to an election of species requirement by canceling all the claims not directed to a plurality of light sources mounted on a flexible substrate with a flexible device for flexing the flexible substrate by applying pressure to the substrate to cause the substrate to deform in a first state and to not deform in a second state to cause the light emitted from the light sources concentrated in different directions in response to the requirement for election of species (09/526,499, amendment of May 23, 2001 and November 15, 2001). Appellant’s “right to claim” was thereby limited to the elected invention.

6. It appears that if the newly added claims were presented during the prosecution of the ‘499 application, these claims would have been restricted out as being directed to an invention that is patentably distinct from the elected invention, and claims 13 to 78 would have been withdrawn from consideration as being directed to a non-elected invention (invention not belonging to the elected invention). The main issue here is that the subject matter of claims 13 to 78 is independent and distinct from the subject matter of the *elected* and patented claims 1-12.

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Applicant would have had no right to examination and issuance of claims 13 to 78 in the original application after acquiescing to the election of species requirement.

7. After foreclosing his right to claim any subject matter other than the invention of a plurality of light sources mounted on a flexible substrate with a flexible device for flexing the flexible substrate by applying pressure to the substrate to cause the substrate to deform in a first state and to not deform in a second state to cause the light emitted from the light sources concentrated in different directions by electing group I, claims 1 to 9, 25, 26 and 50 on May 21, 2001 and by failing to file a divisional application, Applicant cannot now undo the election by contending, on the present record, that his failure to include claims to the independent and distinct inventions of the newly added claims was due to an “error.” *Weiler*, 790 F.2d at 1582, 229 USPQ at 677. Because the non-elected claims were deliberately canceled in the original application to gain examination and allowance of elected claims 1 to 9, 25, 26 and 50, the failure to present claims 13 to 78 in the instant reissue application cannot be considered an error that supports reissuance of the patent within the meaning of 35 U.S.C. § 251, first paragraph.

“[T]he reissue statute was not enacted as a panacea for all patent prosecution problems, nor as a grant to the patentee of a second opportunity to prosecute *de novo* his original application.” *Weiler*, 790 F.2d at 1582, 229 USPQ at 677. If the Applicant cannot claim the subject matter in the original application, he has no “right to claim” it in the reissue. *Weiler*, 790 F.2d at 1581, 229 USPQ at 676; *Cornell*, 150 F.2d at 704, 66 USPQ at 322; *Smyser*, 135 F.2d at 751, 57 USPQ at 406. Allowing Applicant to use the reissue statute to avoid a restriction/election requirement in which he acquiesced would defeat the purpose behind the copendency requirement of §§ 120 and 121 of the statute. *Watkinson*, 900 F.2d at 233, 14 USPQ2d at 1410. The “error” attempted to be corrected here is simply not the type of error that is correctable through reissue.

8. The reissue oath/declaration filed with this application is also defective (see 37 CFR 1.175 and MPEP § 1414) because it fails to identify at least one error which is relied upon as a basis for the reissue application. Any error in the claims must be identified by reference to the specific claim(s) and the specific claim language wherein lies the error. The specific changes or amendments to the claims must be identified. If new claims are presented, their differences from

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the original claims must be pointed out and how they render the original patent wholly or partly inoperative or invalid. Accordingly, the statement "including that added reissue application claims 13 to 78 allow the present invention to be more thoroughly covered" without identifying the specific changes or amendments to the claims and without pointing out their differences from the original claims is not a sufficient explanation for the basis of the present reissue application. 37 CFR 1.175(a)(1) and MPEP § 1414.


9. Claims 1 to 78 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175. The nature of the defect(s) is set forth in the discussion above in this Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y Quach Lee whose telephone number is 571-272-2373. The examiner can normally be reached on Tuesday and Thursday from 8:30 am to 4:30 pm.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service 703-308-2733.

Y. Q.
February 22, 2005


Y Quach Lee
Primary Examiner
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